TITLE 35.—PATENTS

This title was enacted by act July 19, 1952, ch. 950, § 1, 66 Stat. 792

PART I.—PATENT AND TRADEMARK OFFICE

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AMENDMENTS

1975—Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949, substituted "Patent and Trademark Office" for "Patent Office" in part heading and in headings for chapters 2 and 3.

Chapter 1.—ESTABLISHMENT, OFFICERS, FUNCTIONS

Sec.

1. Establishment.
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AMENDMENTS

1972—Pub. L. 92–310, title II, § 208(b), June 6, 1972, 86 Stat. 203, eliminated item 5.

§ 1. Establishment.

The Patent and Trademark Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

CHANGE OF NAME

Section 3 of Pub. L. 93–596 provided that: "The terms 'Patent Office' and 'Commissioner of Patents' in all laws of the United States shall mean 'Patent and Trademark Office' and 'Commissioner of Patents and Trademarks', respectively."

§ 2. Seal.

The Patent and Trademark Office shall have a seal with which letters patent, certificates of trade-mark registrations, and papers issued from the Office shall be authenticated. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 3. Officers and employees.

(a) There shall be in the Patent and Trademark Office a Commissioner of Patents and Trademarks, a Deputy Commissioner, two Assistant Commissioners, and not more than fifteen examiners-in-chief. The Deputy Commissioner, or, in the event of a vacancy in that office, the Assistant Commissioner senior in date of appointment shall fill the office of Commissioner during a vacancy in that office until the Commissioner is appointed and takes office. The Commissioner of Patents and Trademarks, the Deputy Commissioner, and the Assistant Commissioners shall be appointed by the President, by and with the advice and consent of the Senate. The Secretary of Commerce, upon the nomination of the Commissioner, in accordance with law shall appoint all other officers and employees.

(b) The Secretary of Commerce may vest in himself the functions of the Patent and Trademark Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

(c) The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions in grade 17 of the General Schedule of the Classification Act of 1949, as amended. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949; Jan. 2, 1975, Pub. L. 93–601, § 1, 88 Stat. 1956.)

REFERENCES IN TEXT

The Classification Act of 1949, as amended, referred to in subsec. (c), was repealed by section 8(a) of Pub. L. 89–554, Sept. 6, 1966, 80 Stat. 632, and reenacted by the first section thereof as chapter 51 and subchapter III of chapter 53 of Title 5, Government Organization and Employees. The General Schedule is set out under section 5332 of Title 5.

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office", and "Commissioner of Patents and Trademarks" for "Commissioner of Patents", wherever appearing.

Subsec. (a). Pub. L. 93–601 designated former first par. as subsec. (a), and as so designated, redesignated the first assistant commissioner as a Deputy Commissioner, granted authority for the appointment of not more than fifteen examiners-in-chief to the Secretary of Commerce instead of the President, and struck out provision relating to the

performance by the assistant commissioners of duties assigned by the Commissioner.

Subsec. (b). Pub. L. 93–061 designated former third par. as subsec. (b).

Subsec. (c). Pub. L. 93–601 designated former second par. as subsec. (c).

EFFECTIVE DATE OF 1975 AMENDMENTS

Section 4(b) of Pub. L. 93–601 provided that: "This Act [amending this section and sections 7 and 151 of this title, and enacting provisions set out as a note under section 151 of this title] shall be effective upon enactment [Jan. 2, 1975]. Examiners-in-chief in office on the date of enactment shall continue in office under and in accordance with their then existing appointments."

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 4. Restrictions on officers and employees as to interest in patents.

Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 5. Repealed. Pub. L. 92–310, title II, § 208(a), June 6, 1972, 86 Stat. 203.

Section, act July 19, 1953, ch. 950, 86 Stat. 793, related to the bond of the Commissioner and other officers.

§ 6. Duties of Commissioner.

(a) The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; shall have the authority to carry on studies and programs regarding domestic and international patent and trademark law; and shall have charge of property belonging to the Patent and Trademark Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

(b) The Commissioner, under the direction of the Secretary of Commerce, may, in coordination with the Department of State, carry on programs and studies cooperatively with foreign patent offices and international intergovernmental organizations, or may authorize such programs and studies to be carried on, in connection with the performance of duties stated in subsection (a) of this section.

(c) The Commissioner, under the direction of the Secretary of Commerce, may, with the concurrence of the Secretary of State, transfer funds appropriated to the Patent and Trademark Office, not to exceed $100,000 in any year, to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and related matters. These special payments may be in addition to any other payments or contributions to the international organization and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the Government of the United States.

(d) The Commissioner, under the direction of the Secretary of Commerce, may, with the concurrence of the Secretary of State, allocate funds appropriated to the Patent Office, to the Department of State for the purpose of payment of the share on the part of the United States to the working capital fund established under the Patent Cooperation Treaty. Contributions to cover the share on the part of the United States of any operating deficits of the International Bureau under the Patent Cooperation Treaty shall be included in the annual budget of the Patent Office and may be transferred by the Commissioner, under the direction of the Secretary of Commerce, to the Department of State for the purpose of making payments thereof to the International Bureau. (As amended Oct. 5, 1971, Pub. L. 92–132, 85 Stat. 364; Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949; Nov. 14, 1975, Pub. L. 94–131, § 2, 89 Stat. 690.)

AMENDMENTS

1975—Subsec. (a). Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in two places.

Subsec. (c). Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

Subsec. (d). Pub. L. 94–131 added subsec. (d).

1971—Subsec. (a). Pub. L. 92–132 authorized the Commissioner, under direction of Secretary of Commerce, to carry on studies and programs regarding domestic and international patent and trademark laws.

Subsecs. (b), (c). Pub. L. 92–132 added subsecs. (b) and (c).

EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 94–131 effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 7. Board of Appeals.

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, who shall be appointed under the classified civil service. The Commissioner, the deputy commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member

of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal. The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each designated examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions in grade 16 of the General Schedule of the Classification Act of 1949, as amended. The per annum rate of basic compensation of each designated examiner-in-chief shall be adjusted, at the close of the period for which he was designated to act as examiner-in-chief, to the per annum rate of basic compensation which he would have been receiving at the close of such period if such designation had not been made. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949; Jan. 2, 1975, Pub. L. 93–601, § 2, 88 Stat. 1956.)

REFERENCES IN TEXT

The Classification Act of 1949, as amended, referred to in text, was repealed by section 8(a) of Pub. L. 89–554, Sept. 6, 1966, 80 Stat. 632, and reenacted by the first section thereof as chapter 51 and subchapter III of chapter 53 of Title 5, Government Organization and Employees. The General Schedule is set out under section 5332 of Title 5.

AMENDMENTS

1975—Pub. L. 93–601 added provisions relating to the appointment of the examiners-in-chief under the classified civil service, and addition of the deputy commissioner to the Board of Appeals.

Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 93–601 effective Jan. 2, 1975, with examiners-in-chief in office on such date to continue with existing appointment, see section 4(b) of Pub. L. 93–601, set out as a note under section 3 of this title.

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 8. Library.

The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 10. Certified copies of records.

The Commissioner may furnish certified copies of specifications and drawings of patents issued by the Patent and Trademark Office, and of other records available either to the public or to the person applying therefor. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 11. Publications.

(a) The Commissioner may print, or cause to be printed, the following:

1. Patents, including specifications and drawings, together with copies of the same. The Patent and Trademark Office may print the headings of the drawings for patents for the purpose of photolithography.

2. Certificates of trade-mark registrations, including statements and drawings, together with copies of the same.

3. The Official Gazette of the United States Patent and Trademark Office.

4. Annual indexes of patents and patentees, and of trade-marks and registrants.

5. Annual volumes of decisions in patent and trade-mark cases.

6. Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trade-marks, and circulars or other publications relating to the business of the Office.

(b) The Commissioner may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publication desirable for the use of the Patent and Trademark Office. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office", wherever appearing.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

Chapter 2.—PROCEEDINGS IN THE PATENT AND TRADEMARK OFFICE

Sec.
23. Testimony in Patent and Trademark Office cases.

AMENDMENTS

1975—Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949, substituted "Patent and Trademark Office" for "Patent Office" in chapter heading and in item 23.

§ 21. Day for taking action falling on Saturday, Sunday, or holiday.

When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

EMERGENCY RELIEF FROM POSTAL SITUATION AFFECTING PATENT CASES

Relief as to filing date of patent application or patent and excusal of delayed fees or actions affected by postal situation beginning on Mar. 18, 1970, and ending on or about Mar. 30, 1970, see note set out under section 111 of this title.

CROSS REFERENCE

Federal holidays, see section 6103 of Title 5, Government Organization and Employees.

§ 22. Printing of papers filed.

The Commissioner may require papers filed in the Patent and Trademark Office to be printed or typewritten. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 23. Testimony in Patent and Trademark Office cases.

The Commissioner may establish rules for taking affidavits and depositions required in cases in the Patent and Trademark Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in section catchline and text.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 24. Subpoenas, witnesses.

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

* * * * *

(As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in two places.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 25. Declaration in lieu of oath.

(a) The Commissioner may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Commissioner may prescribe, such declaration to be in lieu of the oath otherwise required.

* * * * *

(As amended Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949.)

AMENDMENTS

1975—Subsec. (a). Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 26. Effect of defective execution.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed. (As amended Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trade mark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

Chapter 3.—PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

AMENDMENTS

1975—Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949, substituted "Patent and Trademark Office" for "Patent Office" in chapter heading.

§ 31. Regulations for agents and attorneys.

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent and Trademark Office, and may require them before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 32 of this title; title 5 section 500.

§ 32. Suspension or exclusion from practice.

The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word circular, letter, or advertising, with intent to de-

fraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in title 5 section 500.

§ 33. Unauthorized representation as practitioner.

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in title 5 section 500.

Chapter 4.—PATENT FEES

§ 41. Patent fees.

(a) The Commissioner shall charge the following fees:

1. On filing each application for an original patent, except in design cases, $65; in addition on filing or on presentation at any other time, $10 for each claim in independent form which is in excess of one, and $2, for each claim (whether independent or dependent) which is in excess of ten. For the purpose of computing fees, a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the aditional fees may be rectified in accordance with regulations of the Commissioner.

* * * * *

(b) The Commissioner may establish charges for copies of records, publications, or services furnished by the Patent and Trademark Office, not specified above.

* * * * *

(As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949; Nov. 14, 1975, Pub. L. 94–131, § 3, 89 Stat. 690.)

AMENDMENTS

1975—Subsec. (a)1. Pub. L. 94–131 inserted sentence respecting consideration of a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom as separate dependent claims in accordance with the number of claims to which reference is made for the purpose of computing fees.

Subsec. (b). Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 94–131 effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 13 of this title.

§ 42. Payment of patent fees; return of excess amounts.

All patent fees shall be paid to the Commissioner who, except as provided in sections 361(b) and 376(b) of this title, shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury directs, and the Commissioner may refund any sum paid by mistake or in excess of the fee required by law. (As amended Nov. 14, 1975, Pub. L. 94–131, § 4, 89 Stat. 690.)

AMENDMENTS

1975—Pub. L. 94–131 inserted the exception provision, ", except as provided in sections 361(b) and 376(b) of this title,".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

PART II.—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

Chap. Sec.
13. Review of Patent and Trademark Office Decisions ---------- 141

AMENDMENTS

1975—Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949, substituted "Patent and Trademark Office" for "Patent Office" in heading of chapter 13.

Chapter 10.—PATENTABILITY OF INVENTIONS

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

* * * * *

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371

(c) of this title before the invention thereof by the applicant for patent, or

* * * * *

(As amended July 28, 1972, Pub. L. 92–358, § 2, 86 Stat. 502; Nov. 14, 1975, Pub. L. 94–131, § 5, 89 Stat. 691.)

AMENDMENTS

1975—Par. (e). Pub. L. 94–131 inserted provision for nonentitlement to a patent where the invention was described in a patent granted on an international application by another who has fulfilled the requirements of pars. (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1972—Subsec. (d). Pub. L. 92–358 added reference to inventions that were the subject of an inventors' certificate.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

EFFECTIVE DATE OF 1972 AMENDMENT

Section 3(b) of Pub. L. 92–358 provided that: "Section 2 of this Act [which amended this section] shall take effect six months from the date when Articles 1–12 of the Paris Convention of March 20, 1883, for the Protection of Industrial Property, as revised at Stockholm, July 14, 1967, come into force with respect to the United States and shall apply to applications thereafter filed in the United States."

EMERGENCY RELIEF FROM POSTAL SITUATION AFFECTING PATENT CASES

Relief as to filing date of patent application or patent affected by postal situation beginning on Mar. 18, 1970, and ending on or about Mar. 30, 1970, but patents issued with earlier filing dates not effective as prior art under subsec. (e) of this section of such earlier filing dates, see note set out under section 111 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 363, 375 of this title.

§ 104. Invention made abroad.

In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in sections 119 and 365 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949; Nov. 14, 1975, Pub. L. 94–131, § 6, 89 Stat. 691.)

AMENDMENTS

1975—Pub. L. 94–131 inserted in the exception provision reference to section 365 of this title relating to priority of applications having benefit of filing date of prior applications.

Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 94–131 effective on day entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

Chapter 11.—APPLICATION FOR PATENT

CHAPTER REFERRED TO IN OTHER SECTIONS

This chapter is referred to in sections 371, 373, 375 of this title.

§ 111. Application for patent.

EMERGENCY RELIEF FROM POSTAL SITUATION AFFECTING PATENT, TRADEMARK, AND OTHER FEDERAL CASES

Pub. L. 92–34, June 30, 1971, 85 Stat. 87, as amended by Pub. L. 93–596, § 3, Jan. 2, 1975, 88 Stat. 1949, provided that:

"Section 1 [Claim and verified statement for benefit of earlier filing date; prior art; evidence of entitled filing date in any proceedings]. (a) A patent or trademark application shall be considered as having been filed in the United States Patent and Trademark Office on the date that it would have been received by the Patent and Trademark Office except for the delay caused by the emergency situation affecting the postal service which began on March 18, 1970, and ended on or about March 30, 1970, if a claim is made for the benefit of an earlier date in accordance with subsections (b) and (c) of this section. Patents issued with earlier filing dates afforded by this section shall not be effective as prior art under subsection 102(e) of title 35 of the United States Code [section 102(e) of this title] as of such earlier filing dates.

"(b) No patent or trademark application, patent, or trademark registration shall be entitled to an earlier filing date under this section unless a verified statement by the applicant or owner of record claiming the filing date to which the application is believed to be entitled is filed in the Patent and Trademark Office within six months after enactment of this Act [June 30, 1971]. Such statement shall be maintained in the file of the application in the Patent and Trademark Office and shall be referred to in the patent or trademark registration when practicable.

"(c) When a statement filed under subsection (b) of this section appears unreasonable or defective on its face, or when the filing date of the patent or trademark application, patent, or trademark registration is called into question or is material in any inter partes proceeding in the Patent and Trademark Office or any proceeding in the courts, the applicant or owner of such application, patent, or trademark registration may be required to present evidence establishing the filing date to which the application is entitled. The filing date to which the application is entitled shall be determined on the basis of such evidence and any evidence introduced by an opposing party. The evidence shall be presented as directed by the Commissioner of Patents and Trademarks in proceedings in the Patent and Trademark Office or as directed by the courts in proceedings in the courts.

"Sec. 2 [Delayed fees or actions, excusal; relief request, date; applicability to Federal laws; determination of relief]. (a) Except for the filing of a patent or trademark application, if any action is taken or any fee is paid in the United States Patent and Trademark Office later than the end of a time period specified in the statutes set forth in subsecion (b) of this section for taking such action or paying such fee, and no provision exists in law for excusing such delay, the delay may be excused if it is determined that it was caused by the emergency situation affecting postal service which began on March 18, 1970 and ended on or about March 30, 1970. Relief under this section must be requested by a verified statement filed in the Patent and Trademark Office by the patent or trademark applicant or owner within six months after enactment of this Act [June 30, 1971].

"(b) This section is applicable to title 35, United States Code, 'Patents' [this title]; the Trademark Act of 1946, ch. 540, 60 Stat. 427, as amended [section 1051 et seq. of Title 15]; the Atomic Energy Act of 1954, Pub. L. 83–703, 68 Stat. 919, as amended [section 2011 et seq. of Title 42]; and the National Aeronautics and Space Act, Pub. L. 85–568, 72 Stat. 426 (1958), as amended [sec-

tion 2451 et seq. of Title 42]. In cases involving the Atomic Energy Act of 1954 [section 2011 et seq. of Title 42] or the National Aeronautics and Space Act [section 2451 et seq. of Title 42], determinations of relief shall be made by a Board of Patent Interferences. In other cases determinations shall be made by the Commissioner of Patents and Trademarks.

"Sec. 3 [Regulations]. The Commissioner of Patents and Trademarks may establish regulations for administering this Act."

§ 112. Specification.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be consrued to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (As amended Nov. 14, 1975, Pub. L. 94–131, § 7, 89 Stat. 691.)

AMENDMENTS

1975—Pub. L. 94–131 substituted provision authorizing the writing of claims, if the nature of the case admits, in dependent or multiple dependent form for prior provision for writing claims in dependent form, required claims in dependent form to contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed, substituted text respecting construction of a claim in dependent form so as to incorporate by reference all the limitations of the claim to which it refers for prior text for construction of a dependent claim to include all the limitations of the claim incorporated by reference into the dependent claim, and added paragraph respecting certain requirements for claims in multiple dependent form.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective on day entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 41, 111, 120, 162, 282, of this title.

§ 113. Drawings.

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Commissioner may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim. (As amended Nov. 14, 1975, Pub. L. 94–131, § 8, 89 Stat. 691.)

AMENDMENTS

1975—Pub. L. 94–131 substituted provisions respecting drawings requiring necessary-for-understanding drawings and submission of drawings within prescribed time period and limiting use of drawings submitted after filing date of application for prior provision requiring the applicant to furnish a drawing when the nature of the case admitted it.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 111 of this title.

§ 115. Oath of applicant.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 111, 371 of this title.

§ 119. Benefit of earlier filing date in foreign country; right of priority.

* * * * *

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

* * * * *

Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect

for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing. (As amended July 28, 1972, Pub. L. 92–358, § 1, 86 Stat. 501; Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

1972—Pub. L. 92–358 added last paragraph providing that under certain circumstances, applications for inventors' certificate filed in a foreign country would be given the same priority as applications for patents, if the applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of filing.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

EFFECTIVE DATE OF 1972 AMENDMENT

Section 3(a) of Pub. L. 92–358 provided that: "Section 1 of this Act [which amended this section] shall take effect on the date when Articles 1–12 of the Paris Convention of March 20, 1883, for the Protection of Industrial Property, as revised at Stockholm, July 14, 1967, come into force with respect to the United States and shall apply only to applications thereafter filed in the United States."

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 104, 365, 373 of this title.

§ 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. (As amended Nov. 14, 1975, Pub. L. 94–131, § 9, 89 Stat. 691.)

AMENDMENTS

1975—Pub. L. 94–131 inserted ", or as provided by section 363 of this title," following "filed in the United States".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 121, 365, 373 of this title.

§ 121. Divisional applications.

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 372 of this title.

§ 122. Confidential status of applications.

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

Chapter 12.—EXAMINATION OF APPLICATION

§ 135. Interferences.

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent and Trademark Office.

* * * * *

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

* * * * *

(As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Subsec. (a). Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in two places.

Subsec. (c). Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

Chapter 13.—REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS

AMENDMENTS

1975—Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 1949, substituted "Patent and Trademark Office" for "Patent Office" in chapter heading.

§ 142. Notice of appeal.

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner and shall file in the Patent and Trademark Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 141 of this title.

§ 143. Proceedings on appeal.

The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent and Trademark Office, in writing, touching all the points involved by the reasons of appeal. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 144. Decision on appeal.

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent and Trademark Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent and Trademark Office and govern the further proceedings in the case. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in two places.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 146. Civil action in case of interference.

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District

Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law. (As amended Jan. 2, 1975, Pub.L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in four places.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 141, 291 of this title.

Chapter 14.—ISSUE OF PATENT

§ 151. Issue of patent.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred. (As amended Jan. 2, 1975, Pub. L. 93–601, § 3, 88 Stat. 1956.)

AMENDMENTS

1975—Pub. L. 93–601 substituted "and the delay in payment is shown to have been unavoidable," for "within three months after the due date and sufficient cause is shown for the late payment," in the last paragraph.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–601 effective Jan. 2, 1975, with examiners-in-chief in office on such date to continue with existing appointment, see section 4(b) of Pub. L. 93–601, set out as a note under section 3 of this title.

ACCEPTANCE OF LATE PAYMENT OF ISSUE FEES BY COMMISSIONER

Section 4(a) of Pub. L. 93–601 provided that: "The Commissioner of Patents may, in accordance with Section 3 of this Act [amending this section], accept late payment of issue fees, the payment of which was governed by the provisions of Public Law 89–93 [probably should refer to Public Law 89–83, which amended this section and sections 41, 112, and 151 of this title and section 1113 of Title 15, Commerce and Trade]; *Provided:* the term of the patent for which late payment of such an issue fee is accepted shall expire earlier than the time specified in Section 154 of Title 35, United States Code by a period equal to the delay between the time the application became abandoned or the patent lapsed for failure to pay the issue fee and the time the late payment is accepted after enactment of this Act [Jan. 2, 1975]. *Further Provided:* no patent with respect to which the issue fee was governed by the provisions of PL 89–83 and for which a late payment of the issue fee is accepted under the authority created by Section 3 of this Act, shall abridge or affect the right of any person or his successors in business who made, purchased or used anything covered by the patent, after the date of the application became abandoned or patent lapsed for failure to pay the issue fee but prior to the grant or restoration of the patent, to continue the use of or to sell to others to be used or sold, the specific thing so made, purchased, or used. A court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made after the date the application became abandoned or patent lapsed for failure to pay the fee but prior to the grant or restoration of the patent, and it may also provide for the continued practice of any process covered by the patent, practiced, or for the practice of which substantial preparation was made, after the date the application became abandoned or patent lapsed for failure to pay the issue fee but prior to the grant or restoration of the patent, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant or restoration of the patent."

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 267 of this title.

§ 152. Issue of patent to assignee.

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 153. How issued.

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent and Trademark Office designated by the Commissioner, and shall be recorded in the Patent Office. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in three places.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

Chapter 17.—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

CHAPTER REFERRED TO IN OTHER SECTIONS

This chapter is referred to in section 368 of this title; title 42 sections 2457, 5908.

PART III.—PATENTS AND PROTECTION OF PATENT RIGHTS

Chapter 25.—AMENDMENT AND CORRECTION OF PATENTS

Sec.

254. Certificate of correction of Patent and Trademark Office mistake.

AMENDMENTS

1975—Pub. L. 93–596, § 1, Jan. 2, 1975, 88 Stat. 149 substituted "Patent and Trademark Office" for "Patent Office" in item 254.

§ 253. Disclaimer.

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 254. Certificate of correction of Patent and Trademark Office mistake.

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office" in section catchline and in text.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 255. Certificate of correction of applicant's mistake.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

SECTIONS REFERRED TO IN OTHER SECTIONS

This section is referred to in section 41 of this title.

Chapter 26.—OWNERSHIP AND ASSIGNMENT

§ 261. Ownership; assignment.

* * * * *

An assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

Chapter 29.—REMEDIES FOR INFRINGEMENT OF PATENT AND OTHER ACTIONS

§ 282. Presumption of validity; defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

* * * * *

(As amended Nov. 14, 1975, Pub. L. 94–131, § 10, 89 Stat. 692.)

AMENDMENTS

1975—First par. Pub. L. 94–131 made presumption of validity applicable to claim of a patent in multiple dependent form and multiple dependent claims and substituted "asserting such invalidity" for "asserting it".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 94–131 effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 288. Action for infringement of a patent containing an invalid claim.

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent and Trademark Office before the

commencement of the suit. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

§ 293. Nonresident patentee; service and notice.

Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court. (As amended Jan. 2, 1975, Pub. L. 93–596, § 1, 88 Stat. 1949.)

AMENDMENTS

1975—Pub. L. 93–596 substituted "Patent and Trademark Office" for "Patent Office"

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93–596 effective Jan. 2, 1975, see section 4 of Pub. L. 93–596, set out as a note under section 1111 of Title 15, Commerce and Trade.

PART IV.—PATENT COOPERATION TREATY

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CODIFICATION

Analysis of chapters editorially supplied. Part IV added without adding analysis for Chapters 35, 36, and 37.

Chapter 35.—DEFINITIONS

Sec.
351. Definitions.

§ 351. Definitions.

When used in this part unless the context otherwise indicates—

(a) The term "treaty" means the Patent Cooperation Treaty done at Washington, on June 19, 1970, excluding chapter II thereof.

(b) The term "Regulations", when capitalized, means the Regulations under the treaty excluding part C thereof, done at Washington on the same date as the treaty. The term "regulations", when not capitalized, means the regulations established by the Commissioner under this title.

(c) The term "international application" means an application filed under the treaty.

(d) The term "international application originating in the United States" means an international application filed in the Patent Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.

(e) The term "international application designating the United States" means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term "Receiving Office" means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The term "International Searching Authority" means a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term "International Bureau" means the international intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 685.)

EFFECTIVE DATE

Section 11 of Pub. L. 94–131 provided that:

"(a) Section 1 of this Act [enacting this part] shall come into force on the same day as the entry into force of the Patent Cooperation Treaty with respect to the United States. It shall apply to international and national applications filed on and after this effective date, even though entitled to the benefit of an earlier filing date, and to patents issued on such applications.

"(b) Sections 2 to 10 of this Act [enacting section 6(d) and amending sections 41(a) 1, 42, 102(e), 104, 112, 113, 120, and 282 of this title] shall take effect on the same day as section 1 of this Act [enacting this part] and shall apply to all applications for patent actually filed in the United States on and after this effective date, as well as to international applications where applicable.

"(c) Applications for patent on file in the Patent Office on the effective date of this Act, and patents issued on such applications, shall be governed by the provisions of title 35, United States Code [this title], in effect immediately prior to the effective date of this Act."

Chapter 36.—INTERNATIONAL STAGE

Sec.
361. Receiving Office.
362. International Searching Authority.
363. International application designating the United States: Effect.
364. International stage: Procedure.
365. Right of priority; benefit of the filing date of a prior application.
366. Withdrawn international application.
367. Actions of other authorities: Review.
368. Secrecy of certain inventions; filing international applications in foreign countries.

§ 361. Receiving Office.

(a) The Patent Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agreement made between the United States and another country, the Patent Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

(b) The Patent Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of interna-

tional fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent Office shall be in the English language.

(d) The basic fee portion of the international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall be paid on filing of an international application. Payment of designation fees may be made on filing and shall be made not later than one year from the priority date of the international application. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 686.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 42, 376 of this title.

§ 362. International Searching Authority.

The Patent Office may act as an International Searching Authority with respect to international applications in accordance with the terms and conditions of an agreement which may be concluded with the International Bureau. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 686.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 363. International application designating the United States: Effect.

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent Office except as otherwise provided in section 102(e) of this title. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 686.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 120 of this title.

§ 364. International stage: Procedure.

(a) International applications shall be processed by the Patent Office when acting as a Receiving Office or International Searching Authority, or both, in accordance with the applicable provisions of the treaty, the Regulations, and this title.

(b) An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Commissioner of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 686.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 365. Right of priority; benefit of the filing date of a prior application.

(a) In accordance with the conditions and requirements of section 119 of this title, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirement of the first paragraph of section 119 of this title and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120 of this title, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Commissioner may require the filing in the Patent Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 686.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 104, 366 of this title.

§ 366. Withdrawn international application.

Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect and shall be considered as not having been made. However, such international application may serve as the basis for a claim of priority under section 365 (a) and (b) of this part, if it designated a country other than the United States. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 687.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 367. Actions of other authorities: Review.

(a) Where a Receiving Office other than the Patent Office has refused to accord an international filing date to an international application designating the United States or where it has held such application to be withdrawn either generally or as to the United States, the applicant may request review of the matter by the Commissioner, on compliance with the requirements of and within the time limits specified by the treaty and the Regulations. Such review may result in a determination that such application be considered as pending in the national stage.

(b) The review under subsection (a) of this section, subject to the same requirements and conditions, may also be requested in those instances where an international application designating the United States is considered withdrawn due to a finding by the International Bureau under article 12(3) of the treaty. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 687.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 366 of this title.

§ 368. Secrecy of certain inventions; filing international applications in foreign countries.

(a) International applications filed in the Patent Office shall be subject to the provisions of chapter 17 of this title.

(b) In accordance with article 27(8) of the treaty, the filing of an international application in a country other than the United States on the invention made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 of this title, whether or not the United States is designated in that international application.

(c) If a license to file in a foreign country is refused or if an international application is ordered to be kept secret and a permit refused, the Patent Office when acting as a Receiving Office or International Searching Authority, or both, may not disclose the contents of such application to anyone not authorized to receive such disclosure. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 687.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

Chapter 37.—NATIONAL STAGE

Sec.
371. National stage: Commencement.
372. National stage: Requirements and procedure.
373. Improper applicant.
374. Publication of international application: Effect.
375. Patent issued on international application: Effect.
376. Fees.

§ 371. National stage: Commencement.

(a) Receipt from the International Bureau of copies of international applications with amendments to the claims, if any, and international search reports is required in the case of all international applications designating the United States, except those filed in the Patent Office.

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2) of the treaty, at which time the applicant shall have complied with the applicable requirements specified in subsection (c) of this section.

(c) The applicant shall file in the Patent Office—

(1) the national fee prescribed under section 376(a)(4) of this part;

(2) a copy of the international application, unless not required under subsection (a) of this section or already received from the International Bureau, and a verified translation into the English language of the international application, if it was filed in another language;

(3) amendments, if any, to the claims in the international application, made under article 19 of the treaty, unless such amendments have been communicated to the Patent Office by the International Bureau, and a translation into the English language if such amendments were made in another language;

(4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants.

(d) Failure to comply with any of the requirements of subsection (c) of this section, within the time limit provided by article 22 (1) or (2) of the treaty shall result in abandonment of the international application.

(e) After an international application has entered the national stage, no patent may be granted or refused thereon before the expiration of the applicable time limit under article 28 of the treaty, except with the express consent of the applicant. The applicant may present amendments to the specification, claims and drawings of the application after the national stage has commenced.

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 688.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 102, 366, 376 of this title.

§ 372. National stage: Requirements and procedure.

(a) All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent Office.

(b) In case of international applications designating but not originating in, the United States—

(1) the Commissioner may cause to be reexamined questions relating to form and contents of the application in accordance with the requirements of the treaty and the Regulations;

(2) the Commissioner may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations.

(c) Any claim not searched in the international stage in view of a holding, found to be justified by the Commissioner upon review, that the international application did not comply with the requirement for unity of invention under the treaty and the Regulations, shall be considered canceled, unless payment of a special fee is made by the applicant. Such special fee shall be paid with respect to each claim not searched in the international stage and shall be submitted not later than one month after a notice was sent to the applicant informing him that the said holding was deemed to be justified. The payment of the special fee shall not prevent the Commissioner from requiring that the international application be restricted to one of the inventions claimed therein under section 121 of this title, and within the scope of the requirements of the treaty and the Regulations. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 689.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 376 of this title.

§ 373. Improper applicant.

An international application designating the United States, shall not be accepted by the Patent Office for the national stage if it was filed by anyone not qualified under chapter 11 of this title to be an applicant for the purpose of filing a national application in the United States. Such international applications shall not serve as the basis for the benefit of an earlier filing date under section 120 of this title in a subsequently filed application, but may serve as the basis for a claim of the right of priority under section 119 of this title, if the United States was not the sole country designated in such international application. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 689.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 374. Publication of international application: Effect.

The publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 689.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 375. Patent issued on international application: Effect.

(a) A patent may be issued by the Commissioner based on an international application designating the United States, in accordance with the provisions of this title. Subject to section 102(e) of this title, such patent shall have the force and effect of a patent issued on a national application filed under the provisions of chapter 11 of this title.

(b) Where due to an incorrect translation the scope of a patent granted on an international application designating the United States, which was not originally filed in the English language, exceeds the scope of the international application in its original language, a court of competent jurisdiction may retroactively limit the scope of the patent, by declaring it unenforceable to the extent that it exceeds the scope of the international application in its original language. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 689.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

§ 376. Fees.

(a) The required payment of the international fee, which amount is specified in the Regulations, shall be paid in United States currency. The Patent Office may also charge the following fees:

(1) A transmittal fee (see section 361(d));

(2) A search fee (see section 361(d));

(3) A supplemental search fee (to be paid when required);

(4) A national fee (see section 371(c));

(5) A special fee (to be paid when required; see section 372 (c));

(6) Such other fees as established by the Commissioner.

(b) The amounts of fees specified in subsection (a) of this section, except the international fee, shall be prescribed by the Commissioner. He may refund any sum paid by mistake or in excess of the fees so specified, or if required under the treaty and the Regulations. The Commissioner may also refund any part of the search fee, where he determines such refund to be warranted. (Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 690.)

EFFECTIVE DATE

Section effective on day of entry into force of Patent Cooperation Treaty with respect to United States, see section 11 of Pub. L. 94–131, set out as a note under section 351 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 42, 361, 371 of this title.

TITLE 35.—APPENDIX
RULES OF THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Effective January 1, 1974

As Amended to January 18, 1976

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1. THE COURT

Rule 1.1 Name—Seal.

(a) Name. The name of the court as fixed by Chapter 9 of Title 28 of the United States Code is "United States Court of Customs and Patent Appeals."

(b) Seal. The seal of the court shall contain on its outer edge the legend "Seal of the United States Court of Customs and Patent Appeals" with a star interposed between the end of the word "Appeals" and the beginning of the word "Seal"; and in its center an eagle with spread wings within a border of thirteen stars. The clerk shall be the keeper of the seal which shall be the means of authentication of all records and certificates issued from this court.

Rule 1.2 Clerk.

(a) Office. The clerk's office shall be in Washington, D.C., and shall be open for business daily except on Saturdays, Sundays and legal holidays in the District of Columbia, from 8:30 a.m. to 4:30 p.m. [See Rule 5.2].

(b) Records. The clerk shall have custody of the records of the court and shall keep separate docket records of each matter pending before the court, assigning consecutive docket numbers thereto. Every paper filed shall show its filing date and be entered on the appropriate docket record. Any person may, except where restricted by law or where the court otherwise directs, have access to such records. [See 28 USC 2637]. Copies thereof may be obtained on payment of prescribed fees set by the court. [See Rule 5.15]. The clerk may permit any original record to be taken from the court upon such statement of need and on such conditions as he may require.

Rule 1.3 Sessions.

Sessions of the court will be held beginning with the first Monday in October of each year and thereafter as announced by the court. Sessions will commence at 10 a.m. Motions for admission to the bar will be entertained at the opening of each session of court. [See Rule 2.1].

Rule 1.4 Applicability and Waiver of Rules.

(a) Federal Rules of Appellate Procedure. The Federal Rules of Appellate Procedure shall govern any practice or procedure not specifically covered by these rules.

(b) Applicability. The rules set forth in part 3 are applicable to appeals from the United States Customs Court, the United States International Trade Commission, the Secretary of Commerce, and the Secretary of Agriculture. The rules set forth in part 4 are applicable to appeals from the Patent and Trademark Office. All other rules are applicable to all appeals filed in this court.

(c) Waiver. On motion and for good cause or at the court's own instance, the court may waive or modify any provision of these rules or waive any provision of the Federal Rules of Appellate Procedure.

Rule. 1.5 Employees and Former Employees not to Practice.

No employee of the court shall engage in the practice of law; nor shall any former employee practice before the court at any time in connection with any case in which the court has made any ruling, or which the court has heard or decided, during his employment.

2. ATTORNEYS AND COUNSELORS

Rule 2.1 Admission to the Bar.

(a) Qualification. An attorney who is admitted to practice before the Supreme Court of the United States, the highest court of a state, any United States Court of Appeals, the United States Court of Claims, a United States District Court (including the district courts for Puerto Rico, the Canal Zone, Guam, and the Virgin Islands), the United States Customs Court, or the District of Columbia Court of Appeals, and who is of good moral and professional character is eligible for admission to the bar of this court.

(b) Oath. An applicant shall take or subscribe the following oath or affirmation:

"I, _____
do solemnly swear or affirm that I will demean myself as an attorney and counselor of this court, uprightly and according to law; and that I will support the Constitution of the United States. So help me God."

(c) By Motion. An attorney may be admitted in open court by appearing personally with a sponsor who is a member of the bar of this court, who states the applicant's qualifications and moves his admission. [See Rule 1.3].

(d) By Certificate. An attorney may be admitted without appearing personally by furnishing the following evidence of his eligibility: (1) a statement, signed by him and a member of the bar of this court, on a form provided by the clerk; (2) a certificate from a court listed in subsection (a) of this rule, showing he is a member of the bar thereof in good standing; and (3) an executed oath on a form provided by the clerk.

(e) Fee. As a condition of admission, an applicant shall pay the fee provided in Rule 5.15, and this shall entitle him to a certificate of admission.

Rule 2.2 Appearances.

The filing of a notice or petition of appeal submitted by a member of the bar of this court shall constitute a notice of appearance by said member. It is not necessary for government counsel to file or serve notices of appearance in cases in which the government is a party. A notice or petition of appeal subscribed by a non-member of the bar of this court may be filed, but no further proceedings shall be had with respect thereto, other than dismissal of the appeal, until the filing of a notice of appearance by a member of the bar of this court. Not later than ten days after notice of the docketing of an inter partes appeal, counsel who will represent the appellee or respondent shall file and serve a notice of appearance. A party desiring to appear without counsel may

so notify the clerk in writing and shall be deemed to have appeared on his own behalf.

Rule 2.3 Suspension—Disbarment.

When it is shown to the court that any member of its bar has been suspended from practice or disbarred in any other court, or has been guilty of conduct unbecoming a member of the bar of the court, he will be subject to suspension or disbarment by the court. The member shall be afforded an opportunity to show cause, within such time as the court shall prescribe, why he should not be suspended or disbarred. Upon his response to the order to show cause, and after hearing, if requested, or upon expiration of the time prescribed for a response if no response is made, the court may enter an appropriate order.

3. CUSTOMS, TARIFF, COMMERCE, AND AGRICULTURE CASES

Rule 3.1 Appeal—How Taken.

(a) Notice of Appeal. Any party dissatisfied with any appealable decision of the United States Customs Court, the United States International Trade Commission, the Secretary of Commerce, or the Secretary of Agriculture may have a review of said decision (under 28 USC 2601, 19 USC 1337, Headnote 6 to Schedule 8, Part 4 of the Tariff Schedules of the United States, or 28 USC 1545, respectively) by filing a notice of appeal, in duplicate, in the office of the clerk of this court. A copy of the notice shall be served on the adverse parties. When the United States is the appellant, a copy shall be served on the attorney of record or on the party pro se; in all other cases, a copy shall be served on the appropriate government officials or their designees. [See Rule 5.1]. In all cases where the United States is not the appellant, such notice of appeal shall be accompanied by the filing fee specified in Rule 5.15.

(b) Assignment of Errors. The party filing a notice of appeal shall attach to all copies of such notice a concise statement of errors of law and fact complained of.

Rule 3.2 Application for Permission to Appeal.

(a) How Filed. The party seeking permission to appeal under 28 USC 1541(b) shall file with the clerk of this court an original and 12 copies of an application which shall include a statement of the facts necessary to an understanding of the controlling question of law determined by the interlocutory order of the United States Customs Court or by the order entered by the chief judge of the United States Customs Court under 28 USC 256(b), a statement of the issue involved or question presented, and a statement of the reasons why the court should grant the application. The application shall also include or have annexed thereto a copy of the order from which appeal is sought and of any findings of fact, conclusions of law, or opinion relating thereto. If the appellant is the United States, a copy shall be served on the attorney of record or the party pro se; in all other cases, a copy shall be served on the Attorney General and the Secretary of the Treasury or their designees. [See Rule 5.1]. In all cases where the United States is not the applicant, the application shall be accompanied by the filing fee specified in Rule 5.15.

(b) Answer in Opposition. Within 10 days after service of the application, an adverse party may file an original and 12 copies of an answer in opposition.

(c) Format. The application and answer thereto may be typewritten but the copies thereof shall be of a clarity equal to that of the original. [See Rule 5.14].

(d) Submission. The application and answer shall be submitted without oral argument unless otherwise ordered.

Rule 3.3 Record on Appeal.

(a) Time for Transmission. Upon the filing of a notice of appeal or the granting of an application for permission to appeal, the clerk of this court shall request the appropriate government official to certify the record and transmit it to this court for filing within 30 days from the date of the request unless the time is extended as provided in subsection (d) of this rule.

(b) Contents of Records. The record to be transmitted shall include (1) pleadings, dispositive motions and related memoranda, stipulations, and testimony, (2) the decision, judgment, or order appealed from, any motion for rehearing and supporting papers, and all opinions, memoranda, findings of fact, or conclusions of law related thereto, (3) all exhibits introduced, (4) a certified copy of the docket sheet, and (5) a certified list of the foregoing documents and exhibits, identified with reasonable definiteness.

(c) Correction or Modification of the Record. Prior to the transmittal of the record, if error or omission therein appears with respect to anything material to the case of either party, the parties by stipulation, or the appropriate tribunal or official, may direct that the error or omission be corrected. After transmittal of the record, all questions as to form and content of the record shall be presented to this court and this court, on motion or on its own initiative, may direct that the error or omission be corrected, and, if necessary, that a supplemental record be certified and transmitted.

(d) Extension of Time for Transmission of Record. An extension of time for transmitting the record may be granted by the court for good cause shown upon application by the appropriate government official referred to in subsection (a) of this rule, within the time originally prescribed.

4. PATENT AND TRADEMARK CASES

Rule 4.1 Appeal—Docketing.

(a) Petition. In appeals from the Patent and Trademark Office appellant shall file a petition, addressed to the court, praying that the appeal be heard. The petition shall be accompanied by the filing fee specified in Rule 5.15. [See Rule 2.2].

(b) Time to File. Said petition with proof of service on opposing counsel and a certified copy of the record in the proceeding shall be filed in this court

within 40 days from the date the notice of appeal under 35 USC 142 or 15 USC 1071(a) was filed in the Patent and Trademark Office: *Provided*, That the Commissioner of Patents and Trademarks may for sufficient cause set a new period to end on some definite date; and *Provided further*, That in inter partes cases appellant shall, at the time of filing said petition, serve a copy thereof upon appellee or his counsel.

(c) Docketing. An appeal will be docketed upon timely receipt of a petition, the filing fee, and a certified copy of the record. The date of docketing and the appeal number will be transmited to counsel promptly thereafter.

(d) Failure to File. Election Under 35 USC 141 and 15 USC 1071(a). If said petition of appeal and copy of said record along with prescribed fee shall not be filed within said period of 40 days, or within the period set by the Commissioner, as above provided, or if a notice of election is filed under 35 USC 141 or 15 USC 1071(a), the Commissioner may take such further proceedings as may be necessary to dispose of the case as though no notice of appeal had ever been given. [See Rule 6.3].

Rule 4.2 Certification and Transmittal of Record.

(a) Transmittal. The Commissioner of Patents and Trademarks shall transmit to this court as the record certified copies of those portions designated by the parties. There shall be included the decision or ruling to be reviewed, together with any opinions or memoranda related thereto; the pleadings, if any; the notice of appeal; and the designations or stipulations of the parties as to the contents of the record. A certificate of the transmitting officer identifying the papers with reasonable definiteness shall accompany the record.

(b) Omissions. In making up the record the Commissioner shall omit the following unless expressly designated by a party to be included:

(1) Face and back of file wrappers; formal indorsements on backs of papers.

(2) Printed letterheadings and the like. Examiners' letters and other office letters need show only the paper number short title, date, address, serial or case number, body of letter, and signature.

(3) Notices of publication, hearings, decisions allowance, receipt of fees, and reference slips, interference cards, and the like except when material to some question raised on the appeal, and then merely a memorandum need be made—e.g., "Memorandum: Notice of allowance mailed to_____, address _____, date _____".

(4) A patent or other instrument already included, but reference shall be made thereto by memorandum at the appropriate place, if necessary.

(c) Correction or Modification of the Record. If error or omission with respect to anything material to the case of either party occurs in the record, the parties by stipulation, or the court on motion or on its own initiative, may direct that the error or omission be corrected, and, if necessary, that a supplemental record be certified and transmitted.

5. PRACTICE

Rule 5.1 Service.

(a) Manner of Service. Service may be personal or by mail on each adverse party. Personal service includes delivery to a responsible person at the office of counsel. Service by mail is complete on mailing.

(b) Proof of Service. Papers presented for filing and required to be served shall contain an acknowledgment of service by or on behalf of the person served or proof of service in the form of a statement of the date and manner of service and, in the case of personal service, of the name of any person served, certified by the person who made service. Proof of service may appear on or be affixed to the papers filed. The clerk may permit papers to be filed without acknowledgement or proof of service but shall require such proof to be filed promptly thereafter.

Rule 5.2 Time.

(a) Computation. In computing any period of time, the day from which the period begins to run shall be excluded. The last day of the period so computed shall be included, unless it is a Saturday, Sunday, or legal holiday, in which event the period runs until the end of the next day which is not a Saturday, Sunday, or legal holiday. When the period of time prescribed or allowed is less than 7 days, intermediate Saturdays, Sundays, and legal holidays shall be excluded in the computation.

(b) Legal Holidays. The term "legal holiday" as used in these rules means legal holidays in the District of Columbia, which are:

New Year's Day, January 1.
Inauguration Day, every fourth year.
Washington's Birthday, third Monday in February.
Memorial Day, last Monday in May.
Independence Day, July 4.
Labor Day, first Monday in September.
Columbus Day, second Monday in October.
Veterans Day, fourth Monday in October.
Thanksgiving Day, fourth Thursday in November.
Christmas Day, December 25.
Any day designated as a holiday by the President or the Congress.

When a legal holiday falls on Sunday, the next day is a holiday. When a legal holiday falls on Saturday, the preceding day is a holiday.

(c) Service by Mail—Added Time. Whenever a party is required or permitted to do an act within a prescribed period after service of a paper upon him and the paper is served by mail, 3 days shall be added to the prescribed period.

(d) Extension. When an action is required or allowed at or within a specified time not set by statute, the court or a judge thereof, or the clerk as provided for in Rule 5.3(e), for cause shown, may, upon motion, (1) order the period enlarged if application therefor is made before the expiration of the period originally prescribed or as extended by a previous order, or (2) permit the action to be taken after the expiration of the specified period where the failure to act was excusable.

Rule 5.3 Motions.

(a) Requirements. An application for an order or other relief shall be made by filing a motion therefor in writing. The motion shall state with particularity the grounds therefor and the relief sought. All motions shall be filed with proof of service and accompanied by a proposed order. If a motion is supported by briefs, affidavits, or other papers, they shall be served and filed with the motion.

(b) Response and Reply. Any party may file a response in opposition to a motion within 10 days after service of the motion. Procedural motions under subsection (e) of this rule may be acted upon at any time, without awaiting a response thereto, but any party adversely affected by such action may request reconsideration, vacation, or modification thereof in accordance with subsection (a). A reply may be filed within 5 days after service of a response. Such reply shall be limited to points newly raised in the response and shall not reargue matters presented in the motion. No further responses or replies may be filed.

(c) Format—Number of Copies. Motions, responses, replies and supporting papers, may be typewritten but shall comply with Rule 5.14. If produced by an offset or other printing process they must comply with Rule 5.8(a). Beneath the caption and preceding the body of the motion or supporting paper, there shall be a title succinctly stating the relief sought, for example: *"Motion to Extend Time to File Appellant's Brief."* An original and at least one copy of all motions, responses, replies and supporting papers, shall be filed.

(d) No Hearing. Unless otherwise ordered by the court, no motion shall be presented and argued in open court except motions presented when the appeal is being argued.

(e) Procedural Motions. The clerk may grant for the court procedural motions which are ordinarily granted, when timely filed, served, consented to or unopposed, and which in the opinion of the clerk would not delay or prejudice the work of the court as follows: to dismiss the appeal, to remand the case, to enlarge the time for filing records, briefs, petitions for rehearing, and supporting papers; to stay mandates; to return records in terminated cases to proper officials; to consolidate cases; to make corrections in briefs or other papers filed in this court; to correct or modify the record; to substitute appearances or parties; and for leave to file briefs in typewritten form or in excess by not more than 10 pages of the page limitations provided by these rules. Any interested party adversely affected by such order shall be entitled to reconsideration thereof by the court if a motion is filed within 10 days after the date of the entry of the order. All other motions shall be decided by the court.

Rule 5.4 Constitutional Questions.

Any party challenging the constitutionality of an Act of Congress in any suit or proceeding to which the United States is not a party shall, upon the filing of the record or as soon thereafter as the question is raised in this court, give immediate notice in writing to the court of the existence of said question, specifying the provision of the act being challenged. The clerk shall thereupon notify the Attorney General of such challenge.

Rule 5.5 Agreed Statement.

When the questions presented by an appeal to this court can be determined without an examination of all the pleadings, evidence, and proceedings below, the parties may submit an agreed statement of the case in lieu of the record as required by Rule 3.3(b) showing: (1) how the questions arose and were decided in the tribunal from which the appeal is taken; (2) the facts averred and proved or sought to be proved which are essential to a decision of the questions by this court; and (3) a concise statement of the issues to be decided and the points to be relied on by appellant. The statement shall be accompanied by a certified copy of the judgment or ruling appealed from and a certified copy of all opinions, if any, in support thereof.

Rule 5.6 Printing of Transcript.

(a) Filing of Transcript—Number of Copies—Composition—Service. Within 90 days after the filing of the record in a customs case or the docketing of a case on appeal from the Patent Office, the appellant shall file 25 printed copies of a transcript of record which shall contain: (1) the relevant docket entries in the proceeding below; (2) relevant pleadings; (3) the judgments, orders, or decisions in question; (4) all appealed claims; (5) counts in interference; and (6) any other parts of the record to which the parties wish to direct the particular attention of the court. Appellant shall serve at least 5 copies of the transcript or each of the other parties to the proceeding. If an agreed statement is filed in accordance with Rule 5.5, 25 copies of said statement and accompanying papers shall be filed as provided above.

Where 2 or more parties appeal as in the case of a cross-appeal or a three party interference proceeding and in the absence of an agreement between the parties, the court will designate who, for the purposes of this rule and Rule 5.10(a), shall be regarded as the appellant.

(b) Determination of Contents. The parties are urged to agree on the contents of the transcript. In the absence of an agreement, appellant shall serve on appellee, not later than 20 days after the filing of the record in a customs case or the docketing of an appeal from the Patent and Trademark Office, a designation of the parts of the record which appellant intends to include in the transcript. If appellee believes the parts of the record designated by appellant are not sufficient, appellee shall, within 10 days after service of the designation, serve upon appellant a designation of additional parts to be included in the transcript. Appellant shall include the parts thus designated in the transcript. [See Rules 3.3 and 4.2]. In designating parts of the record for inclusion in the transcript, the parties shall have regard for the fact that the record on file is available to the court and shall not make unnecessary designations.

(c) Cost of Printing. The cost of producing the transcript shall be paid by the appellant. If appellee

shall cause matter to be included in the transcript which appellant considers unnecessary, appellant may move to impose on appellee the cost of printing such matter. A statement of costs for such matter shall be submitted to the clerk. The court will act on the motion concurrently with the final decision. In cases where two or more parties appeal and the parties cannot agree on the apportionment of printing costs, the court will apportion them.

(d) Contents. The transcript shall contain a table of contents listing the parts of the record in the order in which they appear therein. Asterisks shall be used to indicate omissions from original documents. Immaterial formal matters shall be omitted. In testimony, a question and its answer may be contained in a single paragraph. The transcript shall indicate the pages of the original record.

(e) Omission of Relevant Papers. When any part of the record which is material to the appeal is inadvertently omitted from the transcript, the clerk, on the written request of any party, duly served, may allow such material to be printed as a supplement to the transcript or as an appendix to a brief.

(f) Consolidation of Appeals in Single Transcript. When more than one appeal is taken from the same judgment, decision, or ruling, a single transcript shall be printed containing all material designated by the parties without duplication.

(g) Submission on Record Without Transcript. The court may dispense with the requirement of a transcript and may permit cases to be submitted on the record under such conditions as the court may direct.

(h) Translations. Whenever any paper transmitted to this court is in a language other than English, without a translation thereof, made under the authority of the lower tribunal or admitted to be correct, the court may order that a translation be supplied.

Rule 5.7 Visual Aids.

(a) Used Below. The use in oral argument of illustrative models, specimens, samples, charts, diagrams, and other visual aids is encouraged when it facilitates the presentation. When any visual aid was part of the presentation of the case below and is relied on by any party to the appeal, it shall be placed in the custody of the clerk at least 10 days before the case is heard or submitted. Failure to do so will make its subsequent use discretionary with the court.

(b) Not Used Below. When any visual aid was not part of the presentation of the case below, its proposed use shall be brought to the attention of opposing counsel not less than 15 days prior to the date of hearing. Objections, if any, to the use of such aid shall be in writing, served on all adverse parties, and filed in this court not less than 5 days prior to the hearing date. Use of such aid will be discretionary with the court. This rule shall not preclude agreement of counsel respecting the use of visual aids, or the use of a chalkboard or the equivalent during oral argument.

(c) Disposition. All visual aids in the custody of the clerk, other than official exhibits, must be removed by the parties within 90 days after the case is finally decided. If they are not removed within said period, the clerk may dispose of them.

Rule 5.8 Appearance of Printed Transcripts, Briefs, Motions, and Other Papers.

(a) In General. All transcripts, briefs, motions, and other papers printed for the use of the court may be produced by standard typographic printing or by any process capable of producing a clear black permanent image. Carbon copies of any records or briefs may not be submitted without permission of the court. All printed matter except covers must appear in at least 11 point type on opaque, unglazed paper. If footnotes are included, they may not be printed in type smaller than 9 point. Plastic and metal ring-type bindings are not acceptable.

(b) Cover—Color. The cover of appellant's brief shall be blue; appellee's red; of an intervenor or *amicus curiae*, green; of any reply brief, gray. The cover of petitions for rehearing shall be yellow, and the covers of replies thereto shall be brown. The cover of the transcript shall be white. Covers of any other papers shall be so selected as to distinguish from the above.

(c) Page Size—Customs. The transcript of record and briefs in customs cases shall have pages 6⅛ by 9¼ inches and type matter 4⅛ by 7⅛ inches.

(d) Page Size—Patent and Trademark Office. The transcript of record and briefs in appeals from the Patent and Trademark Office shall have pages 7⅜ by 10¼ inches and type matter 4⅛ by 7⅛ inches to permit incorporation of copies of patent and trademark registrations.

(e) Motions, etc. Motions and other papers may be printed at the option of a party and, if printed, the form thereof shall be governed by the provisions of subsections (a), (c), and (d) of this rule.

(f) Failure To Conform. The clerk may refuse to file any transcript, brief, or other paper which has been printed or bound otherwise than in substantial conformity with this rule.

Rule 5.9 Briefs—Content.

(a) Cover—Content. The front cover of each brief shall contain:

(1) At the top, the title of the document and the designation of the party for whom it is filed (e.g., Brief for Appellant). Immediately beneath the title of the document, a heavy black line shall be printed. Beneath the line, the following matter shall be printed:

(2) The name of this court. [See Rule 1.1(a)].

(3) The docket number and title of the case in this court. [See Rule 1.2(b)]. In the title, appellants, appellees, petitioners, respondents, etc., shall be so designated.

(4) The nature of the proceeding in this court and the name of the court, agency, or board from which the appeal is taken (e.g., appeal from Board of Appeals).

(5) The names, addresses, and telephone numbers of all counsel representing the party on whose behalf the document is filed.

(b) Appellant's Brief. Appellant's brief shall contain sections headed and arranged in the following order:

(1) TABLE OF CONTENTS, with page references, followed by a TABLE OF AUTHORITIES including cases, statutes, textbooks, articles, regulations, rules and the like with references to all pages where they are cited.

(2) STATEMENT OF THE ISSUES. The issues presented separately expressed in short and concise terms.

(3) STATEMENT OF THE CASE. The statement shall first indicate briefly the nature of the case and its disposition below including the statutory basis for review of the judgment, decree, order, or ruling in question. A statement of background may be included. There shall follow a statement of the facts relevant to the issues presented for review with references to the pages of the record at which such facts appear.

(4) ARGUMENT. The argument should be opened with a concise summary of argument which states clearly and succinctly the points made in the brief. The points stated should then be used as headings in the body of the argument.

(5) CONCLUSION. A precise statement of all relief sought.

(c) Appellee's Brief. Appellee's brief shall conform generally to the requirements of subsection (b)(1-5), except that no statement of the issues or statement of the case shall be included unless appellee disagrees with appellant's statements in which event appellee may include restatements as may be deemed necessary.

(d) Reply Brief. A reply brief must be confined to new matter raised in appellee's brief and shall conform generally to the requirements of subsection (b)(1–5).

(e) Citations. Citations of decisions of this court should include the publications in which the decision appears, including, where available, the volume and page of this court's reports, the Federal Reporter, and the United States Patents Quarterly, e.g., *General Instrument Co.* v. *United States*, 59 CCPA 171, C.A.D. 1062, 462 F. 2d 1156(1972); *In re Nelson*, 47 CCPA 1031, 280 F. 2d 172, 126 USPQ 242 (1960). Where reference is made in a brief to certain matters included in the transcript of record, the page number thereof shall be designated as "(R—)."

(f) Length of Brief. The main briefs of the parties shall not exceed 50 pages each. No reply brief shall exceed 25 pages. Pages containing tables of contents, authorities, glossaries, and appendices containing statutes, rules, and the like shall not be counted in determining length.

(g) Cross-Appeals. If a cross-appeal is filed, the party in the position of plaintiff below shall be deemed appellant for purposes of this rule and Rule 5.10 unless the parties otherwise agree or the court otherwise orders. The single main brief of appellee shall contain the issues and argument involved in his cross-appeal as well as the response to the brief of appellant.

Rule 5.10 Filing and Service of Briefs.

(a) Time To File. Appellant's brief shall be served and filed within 60 days after the date on which the transcript is filed. Appellee's brief shall be served and filed within 40 days after service of appellant's brief. Appellant may serve and file a reply brief within 14 days after service of appellee's brief and not later than 5 days prior to hearing. No further briefs may be filed without leave of court.

(b) Number of Copies. 25 copies of each brief shall be filed and 5 copies of each brief shall be served on counsel for each party separately represented.

(c) Extension of Time. No brief will be received after expiration of the time stated in subsection (a) unless such period has been extended as provided in Rule 5.2(d) or good cause is shown.

(d) Consequences of Failure to File Briefs. If an appellant's brief is not filed within the time provided by this rule, or within the time extended, an appellee may ask for dismissal of the appeal or the court may *sua sponte* dismiss the appeal. If an appellee fails to file his brief, he will not be heard at oral argument except by permission of the court.

Rule 5.11 Briefs of Amicus Curiae.

(a) Filing. A brief of *amicus curiae* may be filed only if accompanied by written consent of all parties, or by leave of court on motion under Rule 5.3, and if the brief is presented within the time allowed for the filing of the brief of the party supported. When the United States is not a party, consent or leave need not be obtained when the brief is presented for the United States or any agency thereof.

(b) Motion for Leave. A motion for leave to file shall be served on all parties, shall identify the interest of the movant and shall state the reasons why a brief of *amicus curiae* is desirable and the relevance of such reasons to the disposition of the case. A party served with such a motion may, within 10 days thereafter, file an objection thereto.

(c) Content. All briefs, motions, and replies filed under this rule shall comply with Rules 5.8, 5.9, and 5.10, except that as to content it shall be sufficient to set forth the interest of *amicus curiae*, the argument, and the conclusion.

Rule 5.12 Calendaring and Disposition of Cases.

(a) Notice of Argument. The clerk shall prepare, under the direction of the court, a calendar of cases awaiting argument. In placing cases on the calendar for argument, he shall give preference to appeals and other proceedings entitled to preference by law. The clerk shall give notice to all interested parties of the date assigned for the hearing and shall publish a hearing list in advance of each session.

(b) Expedited Hearing. The court may on motion showing good cause of *sua sponte* advance the date for the hearing of any case and may allow the filing of typewritten briefs in lieu of printed briefs in cases so advanced.

(c) Disposition on Briefs. Whenever the court, *sua sponte*, or upon agreement of the parties, concludes that a case is of such character as not to require oral argument, it may, after notice to the parties,

proceed to disposition of the case without such argument. In such event, opportunity will be given to respond to a reply brief if one has been filed. Notwithstanding an agreement of the parties to waive oral argument, it may, after notice to the parties, be argued.

(d) Disposition on the Record. Whenever the court, *sua sponte*, or upon agreement of the parties, concludes that a case is of such character as not to require oral argument or briefs and may be decided on the record, the case may be designated for expedited disposition on the record. The clerk will notify the parties of said designation.

(e) Cross-Appeals. A cross-appeal shall be argued with the initial appeal.

(f) Frivolous Appeals. If upon review it shall appear to the court that an appeal is frivolous and entirely without merit, the appeal will be dismissed.

(g) Opinions—Publication. All opinions accompanying decisions of this court shall be provided to the parties, shall be public records of the court and shall be accessible to the public unless based upon proceedings held *in camera* or where a motion to seal the record has been granted under Rule 5.13(g). Opinions which do not add significantly or usefully to the body of law or would not have precedential value will not normally be published. Unpublished opinions shall not be cited as precedent and will not be accepted as such by this court except in support of a claim of *res judicata*, collateral estoppel, or law of the case.

Rule 5.13 Oral Argument.

(a) Number of Counsel. Not more than two counsel will be heard for each side in the argument of a case, except by special permission of the court.

(b) Order of Argument. Appellant shall be entitled to open the argument and to conclude it if time remains. Where there is a cross or a third party appeal, the court will advise which party is to open and close.

(c) Time Allowed for Argument. The court will allow such time for oral argument as shall appear to it to enable a fair presentation of the questions involved. Counsel need not use the full time requested or allowed in any appeal and the court may terminate any argument whenever in its judgment further argument is unnecessary. Unless otherwise provided, the maximum time for oral argument shall be as follows:

(1) Customs Appeals: 30 minutes for appellant and 20 minutes for appellee.

(2) Patent Interference Appeals: 30 minutes for appellant and 20 minutes for appellee.

(3) Inter Partes Trademark Appeals: 20 minutes for appellant and 15 minutes for appellee.

(4) Ex Parte Trademark Appeals: 15 minutes for each side.

(5) All Other Appeals: 20 minutes for each side.

(d) Additional time. Counsel may request additional time, not to exceed 15 minutes, by motion filed at least 10 days prior to the date fixed for hearing, stating why the case cannot be adequately presented within the time limitation.

(e) Amicus Curiae Argument. *Amicus curiae* may, with the consent of a party, argue orally on the side of such party, provided that the maximum time permitted under subsection (c) of this rule for oral argument by such party is not extended. Absent such consent, argument by *amicus curiae* may be made only by special leave of court.

(f) Non-Appearance. If appellee fails to appear at the argument, the court will hear argument on behalf of appellant. If appellant fails to appear, the court may hear argument on behalf of appellee. If neither party appears, the appeal will be decided on the briefs.

(g) In Camera Proceeding. In a proper case, where the interests of justice require, and on a convincing showing thereof by motion properly made, the court will sit *in camera*, or seal its record, or both.

(h) Opening. In all cases a full and fair opening must be made.

Rule 5.14 Form of Typewritten Papers.

All papers permitted by these rules to be presented without being typographically printed or otherwise duplicated shall be typewritten upon opaque, unglazed paper 8½ by 11 inches, the typing on each page beginning not less than 1½ inches from the top, with side margins of not less than one inch, and the pages stapled or bound only at the upper left hand corner without backing. [See Rule 5.8(a)]. The typed matter, except quotations, must be double spaced.

Rule 5.15 Fees.

Pursuant to 28 USC 1926, the fees to be charged by the clerk of this court are fixed as follows:

(1) for docketing a case on appeal or review or docketing any other proceeding, except when an appeal is taken by the United States when no payment of fees shall be required	$50.00
(2) for making a copy, except a photocopy, of any record or paper and comparison thereof, per page	1.00
For making a photocopy of any record or paper, per page	.50
For comparing for certification a copy of any record or paper when such copy is furnished by person requesting its certification, per page	.10
For comparing with the original thereof any photocopy of any record or paper, when furnished by the person requesting its certification, per page	.05
(3) for the certification under seal of:	
(a) a printed record	1.00
(b) a brief	1.00
(c) a journal or docket entry, or any other paper, per page	1.00
(4) for each certificate of membership in the bar	1.00
(5) for an admission to the bar and certificate thereof	10.00
(6) for a duplicate certificate of admission to the bar	5.00

6. DISPOSITION OF CAUSES

Rule 6.1 Petition for Rehearing.

A petition for rehearing may be filed within 20 days after entry of judgment. The petition shall comply with the printing and service requirements of Rules 5.8, 5.9 and 5.10. It shall be limited to and state points of law or fact which the petitioner believes the court has overlooked or misapprehended and shall not reargue points already considered by the court. Except by permission of the court, a petition for rehearing shall not exceed 10 pages if produced by standard typographic printing or 15 pages if by any other process. Oral argument on the petition is not permitted. Any opposition to the petition must comply with the printing and service requirements for the petition and be filed within 10 days from date of service of the petition.

Rule 6.2 Mandates.

(a) When Issued. Mandates shall issue to the lower tribunal after 21 days from the date of judgment. The timely filing of a petition for rehearing will stay the mandate until disposition of the petition. If the petition is denied, the mandate shall issue 7 days after denial of the petition. A copy of the opinion or order of the court shall accompany the mandate.

(b) Stay. A stay of the mandate pending application to the Supreme Court of the United States for a writ of certiorari may be granted upon motion served on all parties. The stay shall not exceed 30 days unless the period is extended for cause shown. If during the stay the petition for a writ of certiorari has been filed, the stay will continue until final disposition of the case by the Supreme Court. Upon receipt of an order of the Supreme Court denying the petition, the mandate of the court shall issue.

Rule 6.3 Voluntary Dismissal.

If the parties to any appeal or other proceeding shall sign and file an agreement that the proceeding be dismissed, it shall be dismissed. An appeal may be dismissed on motion of the appellant. If an appeal has not been docketed in this court as provided in Rule 4.1(c), it may be dismissed by the tribunal from which the appeal was taken upon the filing in that tribunal of a stipulation for dismissal signed by all parties, or upon motion by appellant with service upon all other parties.